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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,119	04/13/2001	Rima Kaddurah-Daouk	MBZ-001	4219

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EXAMINER

CHAKRABARTI, ARUN K

ART UNIT

PAPER NUMBER

1634

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/835,119

Applicant(s)
Kaddurah-Daouk

Examiner
Arun Chakrabarti

Art Unit
1634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 20, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 20-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 20-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☒ Other: **Detailed Action**

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DETAILED ACTION

Specification

1. Claims 30, 32, 33, 38, 48, and 55 have been amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 20-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 20-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of identifying human tumor does not reasonably provide enablement for identifying any disease in any living organism. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The Court in *re Wands*, 8 USPQ2d 1400 (CA FC 1988) stated with regard to enablement that

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“Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

Here, the claim is broadly drawn to identifying any disease in any living species. However, the specification does not provide guidance commensurate in scope with this claim, teaching only one human tumor detection assay in Example 6. The specification provides minimal guidance regarding methods for the identification of alternate diseases. It is highly unpredictable whether or what other diseases would be detected in the context of a vast database of diseases. Further, identification of additional disease detection regimen will be by the trial and error method. This trial and error requirement is borne out because the effects of diseases on metabolites or small molecules of the physiological system cannot be readily deduced, even where the metabolic pathways are known. Further, each disease has unpredictable effects on metabolic function, and no general method for a priori selection of disease detection is presented. It would require a large amount of experimentation, potentially including the testing of thousands of animals for thousands of diseases, in order to identify additional metabolic pathways with the claimed functionality. Given the *Wand*'s factors opposing the full scope of enablement including the limited teaching in the specification, the presence of only one working example, the teaching of unpredictability in the

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prior art, the unpredictability of the art, the breadth of the claim, and the large amount of experimentation needed, with only the skill level in the art being neutral towards enablement, it is concluded that undue experimentation is necessary to make and use the invention as broadly claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 4, 20-21, 23-33, 35-38, 40-50, 52, and 55 are rejected under 35 U.S.C. 102(e)

as being anticipated by Kaser et al. (U.S. Patent 6,168,933 B1) (January 2, 2001).

Kaser et al teach a method for metabolically monitoring the effectiveness of a therapeutic agent in a clinical trial (Abstract and Column 1, lines 22-25), comprising:

a) obtaining a small molecule profile from a subject in a clinical trial being treated with a therapeutic agent (Column 15, line 45 to Column 16, line 24 and Column 11, lines 40-44, and Column 13, lines 1-10); and

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b) monitoring changes in the small molecule profile of the subject as an indication of the effectiveness of the therapeutic agent in the subject, thereby monitoring the effectiveness of the therapeutic agent (Column 15, line 45 to Column 16, line 24).

Kaser et al teach a method for identifying disease relevant small molecules affected by an agent (Abstract) comprising:

a) obtaining a small molecule profile of a diseased cellular compartment (Column 11, line 40 to Column 12, line 51); and

b) comparing the small molecule profile of the diseased cell to a standard small molecule profile (Column 12, lines 52-67), thereby identifying the disease relevant small molecules in the diseased cellular compartment (Column 13, lines 12-22 and Column 26, lines 10-25).

Kaser et al teach a method for identifying small molecules regulated, modulated, or associated with a gene (abstract), comprising:

a) obtaining a small molecule profile of a cellular compartment from a genetically modified source (Column 14, lines 48-60); and

b) comparing the small molecule profile to a standard small molecule profile, thus identifying the small molecules regulated, modulated, or associated with a gene (Column 12, lines 52-67).

Kaser et al teach a method for identifying potential cell drug targets (Column 15, lines 45-58), comprising:

a) contacting a labeled disease relevant small molecule with cellular components in a

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nucleic acid or protein array (Column 16, lines 1-17); and

b) identifying interactions between the cell components and the labeled disease relevant small molecule, thus identifying potential cell drug targets (Column 16, lines 17-24).

Kaser et al teach a library of small molecules of a cellular compartment of a cell comprising a searchable array of samples of small molecules isolated from a cellular compartment of an animal cell nucleus (Column 15, line 45 to Column 16, line 24 and Column 3, lines 2-6).

Kaser et al teach a pharmaceutical composition comprising a small molecule which enables to detect a diseased state (Column 16, lines 25-49).

Kaser et al teach the methods, wherein the diseased cellular compartments are human cells and nuclei obtained from patients with metabolic, immunological, neurological, oncological, viral, or other disorder (Column 13, line 36 to Column 14, line 31)

Kaser et al teach a method wherein the small molecule profiles are obtained using radiochemical analysis and fluorescent analysis (Column 13, lines 12-22).

Kaser et al teach a method wherein the expression vector is a portion of the human genome (Column 8, line 54 to column 9, line 60 and Column 19, line 20 to Column 20, line 9).

6. Claims 20, 22, 48, 51, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Polyak et al. (U.S. Patent 6,344,322 B1) (February 5, 2002).

Polyak et al. teach a method for identifying disease relevant small molecules affected by

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an agent (Abstract) comprising:

a) obtaining a small molecule profile of a diseased cellular compartment (Example 1);

and

b) comparing the small molecule profile of the diseased cell to a standard small molecule profile thereby identifying the disease relevant small molecules in the diseased cellular mitochondrial compartment (Example 1 and Figure 1).

Polyak et al teach a library of small molecules of a cellular compartment of a cell comprising a searchable array of samples of small molecules isolated from a cellular compartment of an animal cell mitochondria (Figure 1).

Polyak et al inherently teach a method for determining whether small molecule profiles are from the same individual, comprising:

a) obtaining one or more samples from an individual;

b) determining the small molecule profiles of the samples;

c) obtaining a tissue sample from an unknown source;

d) determining the small molecule profiles of the unknown source; and

e) comparing the small molecule profiles, thus determining whether the small molecule profiles are from the same individual (Column 3, line 56 to Column 4, line 59).

7. Claims 48, and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Ward et al. (U.S. Patent 5,541,310) (July 30, 1996).

Ward et al teach a library of small molecules of a cellular compartment of a cell

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comprising a searchable array of samples of small molecules isolated from a cellular compartment of a chloroplast (Abstract and Examples 1-4).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4, 20-21, 23-50, 52, and 55 are rejected under 35 U.S.C. 103(a) over Kaser et al. (U.S. Patent 6,168,933 B1) (January 2, 2001) in view of Polyak et al. (U.S. Patent 6,344,322 B1) (February 5, 2002)..

Kaser et al teach the method of claims 4, 20-21, 23-33, 35-38, 40-50, 52, and 55 as described above.

Kaser et al do not teach the method wherein the cellular compartment is mitochondria.

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Polyak et al. teach the method wherein the cellular compartment is mitochondria (Abstract, Example 1 and Figure 1).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute and combine the method wherein the cellular compartment is mitochondria of Polyak et al in the method of Kaser et al., since Polyak et al. states, "The invention thus provides the art with new methods of detecting and tracing tumors by examining mitochondrial DNA for the appearance of somatic mutations (Column 1, lines 44-46)." An ordinary practitioner would have been motivated to substitute and combine the method wherein the cellular compartment is mitochondria of Polyak et al in the method of Kaser et al in order to achieve the express advantages, as noted by Polyak et al. of an invention which provides the art with new methods of detecting and tracing tumors by examining mitochondrial DNA for the appearance of somatic mutations.

Response to Amendment

10. In response to amendment, 112(second paragraph) rejection has been withdrawn. However, all other rejections have been properly maintained.

Response to Arguments

11. Applicant's arguments filed on November 20, 2002 have been fully considered but they are not persuasive.

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Applicant argues to withdraw 112 (first paragraph) rejection because the applicant argues that the claimed methods are directed to a method for identifying disease related small molecules by comparing the small molecule profile of a diseased cell to that of a healthy cell and this method is applicable to any given disease. This argument is not persuasive. Applicant's specification does not provide any such basis in order to support the argument; especially the absence of any working example other than tumor detection assay in Example 6 proves the lack of enablement. Given the Wand's factors opposing the full scope of enablement including the limited teaching in the specification, the presence of only one working example, the teaching of unpredictability in the prior art, the unpredictability of the art, the breadth of the claim, and the large amount of experimentation needed, with only the skill level in the art being neutral towards enablement, it is concluded that undue experimentation is necessary to make and use the invention as broadly claimed. Therefore, 112 (first paragraph) rejection is hereby properly maintained.

Applicant argues that Kaser reference does not teach the small molecules of the claimed invention and therefore 102(e) rejection should be withdrawn. Applicant argues that the word "small molecules" was not found in Kaser reference and only the word "nucleic acid or gene" are found. Applicant argues that because Kaser has a preferred embodiment of nucleic acid molecules, Kaser is limited to the preferred embodiment. This argument is not persuasive. As MPEP 2123 states "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 169 USPQ 423 (CCPA 1971)." MPEP 2123 also states "A reference may be relied upon for all that it would have reasonably

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suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories , 10 USPQ2d 1843 (Fed. Cir. 1989).” It is clear that simply because Kaser has a preferred embodiment, this embodiment does not prevent the reference from suggesting broader embodiments in the disclosure and that this does not constitute a teaching away. Although Kaser reference uses nucleic acids of different sizes to detect the disease, the property of small molecules is inherently present in this chemically and structurally identical molecule. For example, Kaser teaches that fragments of any part of a nucleic acid molecule which retains a usable, functional characteristic can be used in the hybridization or amplification technologies in order to detect a disease (Column 4, lines 44-49). Moreover, MPEP 2111 states, “Claims must be given their broadest reasonable interpretation. During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification”. Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than it is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)”. In this case, any fragments of nucleic acids of Kaser which meet the criteria and definition of “small molecules” of the instant invention, can be used to determine the effectiveness of a therapeutic agent in a clinical trial. The same logic is applicable to other 102 rejections.

Applicant is also hereby informed that in presence of “comprising” language of the claims, several small molecules or additional steps can be added to the instant claims. Therefore, Kaser

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reference as well as other references to support 102 rejections are still applicable and hereby properly maintained.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant also argues that there is no motivation to combine the references. This argument is not persuasive, especially in the presence of strong motivation provided by Polyak et al. since Polyak et al. states, "The invention thus provides the art with new methods of detecting and tracing tumors by examining mitochondrial DNA for the appearance of somatic mutations (Column 1, lines 44-46)."

In view of the response to arguments, all rejections except the 112 (second paragraph) rejection, are hereby properly maintained.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory

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period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group analyst Chantae Dessau whose telephone number is (703) 605-1237.

Arun Chakrabarti,
Patent Examiner,
December 10, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600